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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/899,206	07/06/2001	Takahiro Koga	2000-205779US	3583

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EXAMINER

BOVEJA, NAMRATA

ART UNIT PAPER NUMBER

3622

DATE MAILED: 01/13/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/899,206	Applicant(s) KOGA ET AL.	
	Examiner Namrata Boveja	Art Unit 3622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 November 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,13,14,20 and 21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,13,14,20 and 21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 06 July 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>07/06/2001</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 1, 2, 13, 14, 20, and 21 were elected by the applicant in the restriction notice sent on 10/27/2005 and are presented for examination.
2. Amendments to the elected claims, abstract, and the specification as made by the applicant on 10/27/2005 have been entered and considered.
3. The basis for the restriction was that Claims 1, 2, 13, 14, 20, and 21 are drawn to an information providing system using a server and providing ***information to customers using the same or different transfer path and one information receiving terminal***. Whereas, claims 3-12, 15-19, and 22-25, are drawn to an information providing system using a server and ***providing information to customers using two different transfer paths and two different information receiving terminal***. Therefore the restriction requirement is maintained.

Claim Rejections - 35 USC § 112

The second paragraph of 35 U.S.C. 112 is directed to requirements for the claims:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention. There are two separate requirements set forth in this paragraph:
(A) the claims must set forth the subject matter that applicants regard as their invention; and
(B) the claims must particularly point out and distinctly define the metes and bounds of the subject matter that will be protected by the patent grant.

4. Claims 1, 13, and 20 are rejected under 35 U.S.C. 112.

Claims 1, 13, and 20 recite "at least one of first information." There is insufficient antecedent basis for this limitation in the claim, since the composition of the first information was not previously recited.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless – (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1, 2, 13, 14, 20, and 21 are rejected under 102(e) as being anticipated by Thompson et al (Patent Number 6,282,552 hereinafter Thompson).

In reference to claims 1, 13, and 20, Thompson teaches an information providing method, system, and recording medium comprising: information providing means of delivering at least one of first information including a pre-determined program (i.e. a customizable electronic bill) or advertisement and second information including additional information relating to said first information (i.e. instructions for filling out the electronic bill, modifications, or the originator authentication data) (col. 2 lines 34-42, col. 5 lines 17-35, and Figures 1 and 5); and at least one information receiving terminal (i.e. a standard computer) for a customer that receives at least one of said first information and said second information (col. 3 lines 4 to col. 4 lines 39 and Figure 2).

The remainder of the claim uses the terms "**wherein in case of**," and therefore the prior art still satisfies the claim even if it does not particularly point

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out that information can be addressed to an information receiving terminal (i.e. from one computer terminal to another) and can be sent via the same or different transfer paths (i.e. over a broadband or a dial-up connection).

6. **Disclaimer:** The term information transfer path is interpreted to mean either a type of connection such as a telephone dial-up versus a broadband internet connection or to mean that sending information as an embodiment of an e-mail is an information transfer path and sending information directly via the server can be a separate information transfer path.

In reference to claims 2, 14, and 21, Thompson teaches an information providing method, system, and recording medium comprising: first information providing means that delivers via a first information transfer path (i.e. via an e-mail embodiment) (col. 4 lines 19-23) first information including a pre-determined program and advertisement; second information providing means that delivers via a second information transfer path (i.e. using a standalone program or a plug-in for a Web browser) (col. 4 lines 23-39) second information including detailed information relating to said first information (col. 2 lines 34-42, col. 5 lines 17-35, and Figures 1 and 5); and an at least one information receiving terminal for a customer that receives said first information via said first information transfer path and receiving said second information via said second information transfer path, wherein said second information providing means transmits said second information addressed to said at least one information receiving terminal, said second information having been prepared for a said customer corresponding to

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customer information relating to said customer (col. 3 lines 4 to col. 4 lines 39 and Figure 2) using said at least one receiving terminal.

Point of Contact


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Namrata (Pinky) Boveja whose telephone number is 571-272-8105. The examiner can normally be reached on Mon-Fri, 8:30 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on 571-272-6724. The **Central FAX** number for the organization where this application or proceeding is assigned is **571-273-8300**.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 1866-217-9197 (toll-free).

NB

January 9th, 2006


RETTA YEHEDEGA
PRIMARY EXAMINER